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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

*Ex parte* SCOTT F. WATSON and BRUCE FRAZER

Appeal 2008-4744
Application 10/646,192[1]
Technology Center 2600

Decided: October 30, 2008

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,
and KEVIN F. TURNER, *Administrative Patent Judges.*

HAIRSTON, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of

claims 4 to 16, 18 to 35, 37, 41 to 48, 52 to 59, 61, 63, and 72 to 100.[2] We

have jurisdiction under 35 U.S.C. § 6(b).

We will sustain the rejections.

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[1] Application filed August 21, 2003, claiming benefit of priority to U.S.
Provisional Patent Application No. 60/405,157 filed on August 21, 2002.
The real party in interest is Disney Enterprises, Inc.

[2] Claims 1 to 3, 17, 36, 38 to 40, 49 to 51, and 69 to 71 have been canceled.
Claims 60, 62, and 64 to 68 stand withdrawn by the Examiner as being
drawn to a non-elected invention.

<div align="center">THE INVENTION</div>

Appellants' claimed invention is directed to a system and method of broadcasting movies to a set-top box and providing access to movies to a designated user. The movie broadcasting system and method use a set-top box that assists a user in forming a digital home movie library, the system having an antenna and receiver, a hard disk drive for storing broadcast movie data and metadata, and a processor to process the data (Fig. 2; Spec. 3 and 8). The data is broadcast using "packets" which are "assembled" after transmission (Spec. 12).

Claim 4 is representative of the claims on appeal, and it reads as follows:

4. A method of broadcasting a movie to a set-top box, the method comprising:

a content provider broadcasting movie data to a set-top box, the content of the movie data being selected by the content provider;

permitting automatic storage of the movie data broadcast from the content provider onto the set-top box;

permitting assembling the movie data in the set top box to form at least one full movie and associated metadata;

permitting analysis of the metadata to determine when to make the movie available for viewing; and

permitting viewing of the movie in response to a user's selection of the movie.

## THE REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|---|---|---|
| Dodson et al. ("Dodson") | US 6,184,877 B1 | Feb. 6, 2001 |
| Hunter et al. ("Hunter") | US 2002/0056118 A1 | May 9, 2002 |
| Mauro et al. ("Maruo") | US 6,757,909 B1 | June 29, 2004 |
| | | (filed Dec. 29, 1999) |

The Examiner rejected claims 4 to 10, 12 to 16, 18 to 35, 37, 41, 42, 52 to 59, 61, 63, 72 to 77, and 79 to 100 under 35 U.S.C. § 102(e) as being anticipated based upon the teachings of Hunter.

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable based upon the teachings of Hunter.

The Examiner rejected claims 43 to 48 under 35 U.S.C. § 103(a) based upon the teachings of Hunter and Maruo.

The Examiner rejected claim 78 under 35 U.S.C. § 103(a) based upon the teachings of Hunter and Dodson.

## ISSUES

Appellants primarily contend that the applied reference to Hunter does not expressly or inherently teach or suggest the use of metadata or analyzing metadata locally in the processor of the set-top box. (App. Br. 10-14; Reply Br. 4-14). The anticipation and obviousness issues before us all concern whether or not the applied reference to Hunter describes a set-top box which analyzes metadata as set forth in the claims on appeal.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs[3] and the Answer[4] for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## FINDINGS OF FACT

1. As indicated *supra*, Appellants describe and claim a system and method of broadcasting movies to a set-top box and providing access to movies to a designated user by processing or analyzing metadata.

2. Appellants describe metadata in many different ways in the specification, such as: "scheduling information such as dates or times when to make a movie available for viewing, and how long it should remain available" (par. 52), "contract dates" associated with a movie which are a "date/time range outside which content should not be displayed on the set top box" (para. 53), "information about the movie, such as a short textual description, length of movie, genre, rating, actors, actresses, and director" or "information related to its price" (para. 54), movie trailers (paras. 56 and 188), "metadata included to indicate the price" (para. 187), software version number (para. 189), movie information such as rating and duration (para. 192), language (para. 194), and screen width and height tags (para. 196).

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[3] We refer to the most recent Appeal Brief filed September 7, 2007, and the Reply Brief filed December 31, 2007, throughout this opinion.

[4] We refer to the Examiner's Answer mailed October 30, 2007, throughout this opinion.

3. Hunter describes various types of metadata, including but not limited to: movie "title, type, or category" (para. 12); time-based encoding marks to encrypt movie data (paras. 12 and 16); movie preselection information, content listings and transmission schedules (para. 61); decoding header information for preselected movies, programming data, and pricing data (para. 65); "content availability/scheduling data" (para. 68); movie information obtained from the internet such as websites of film producers and movie rating services (para. 76); time-based coding key C issued only when the user has a verified current account (paras. 82 and 83); viewed-content information used for billing purposes (para. 103); "movie preference information" entered by the customer and used to select movies for downloading (paras. 142 and 143); "customer catalog information" used to overwrite movie data (para. 144); customer profile information (para. 153); information on number of plays (para. 154) or time elapsed from first play (para. 161); and error codes used for assembling data packets (paras. 214-16).

4. Hunter teaches a device that analyzes metadata (Fig. 4, CPU 80, RAM 88, SRAM 90; Figs. 11 and 15, central controller 36; Fig. 23, microprocessor 660). Hunter teaches that metadata analysis also occurs at the content provider (central controller 36; paras. 12, 82, 83, 103), and at the user station (CPU 80, SRAM 90, RAM 88 in set-top box 228, paras. 64-68; microprocessor 660 in companion box 610).

5. Hunter teaches analyzing metadata at central controller 36 such as "movie preference information" to permit downloads (para. 142), analyzing ID headers relating to customer movie preference information to determine which movies are selected for downloading (para. 143), using central

controller 36 to "analyze customer preference information and customer order information" to "determine which movies will be automatically downloaded at that customer's user station" (para. 144), and using "customer catalog information" for "analysis at module 340" (para. 144).

6. Hunter teaches analyzing metadata at user station 28 shown in Figure 4. Metadata such as "headers in the datastream indicating movies or other content that have been preselected for recording," "programming data … including "content availability/scheduling data and content pricing data" (para. 65), and "time-based security codes B" (para. 68) are received by CPU 80 and used to control first-in-first-out processing/deleting/availability of movie data (paras. 128, 138, and 139). Hunter teaches that CPU 80 works in cooperation with decoder 82 to locate preselected movies and then permits recording based on scheduling data (paras. 65 and 68).

7. Hunter teaches analyzing metadata at companion box 610 shown in Figure 23. Metadata such as "customer profile information" (para. 153), "number of plays" (para. 154), channel tuning information (para. 157), "purchase-to-play time" (para. 161) are analyzed in microprocessor 660.

8. Hunter teaches packetizing movie data for transmission and re-transmission (para. 214), and transmitting movie data by phone, internet, or satellite and detecting and fixing data losses for the purpose of ensuring better movie recordings (paras. 212-16). Hunter teaches that bad packets are replaced by re-broadcasting via satellite when wider bandwidth is needed (para. 215). Hunter describes that new release movies "may be transmitted several times per day" (para. 61), that "[e]ach new release movie is transmitted every day on the hour … and several other times daily" (para.

113), and that "new release movies are transmitted every 30 minutes from
5:30 pm to 8:30 pm, and at several other times daily" (para. 119).

     9. Hunter was cited by the Examiner for a teaching of a broadcast
provider that "controls downloading of a movie into the storage device, and
controls the available time of the downloaded movies." (Ans. 22, citing
Hunter, para. 139). Hunter teaches a system for accessing movies having an
antenna 24 and tuner (28, 30, and paras. 128 and 129), a processor 80 with
software for processing data, and a hard disk drive 230 for storing movie
data (para. 128 states that storage device 230 is "preferably … a large hard
disk drive").

     10. According to the Examiner, it would have been obvious to the
skilled artisan to "select any time before making the stored movie available
depend on the capability and characteristics of the transmission medium,
device limitations, times, [or] operator's desire" and to "modify Hunter to
include storing the movie to be any time period such as at least one day, and
preferably about a week" as long as "the time desired is limited to the
capability and/or characteristics of the transmission medium and/or device
limitations and/or operator desire to improve efficiency of movie services."
(Ans. 22).

     11. Hunter was cited by the Examiner as playing a video and reacting
to signals from a remote control and modem activity (Ans. 22-23 citing
Hunter, Figs. 4 and 11 and para. 76). Hunter teaches that "[p]urchases may
be made during the movie by appropriate means" (para. 148). Hunter
describes a handheld remote control 70 associated with a set-top box 228
(Figs. 3 and 11) which controls an internet connection via modem 87 (Fig.
4), modem 235 (Fig. 11), or modem 650 (Fig. 23). Hunter teaches that "[a]

remote control … allows ordering a variety of merchandise … through box 610's IR port, processor and modem communication link" (para. 159). With regard to modem 650, Hunter describes "ordering and paying for a pizza while watching a football game at a friend's house," and describes the remote control "also allow[s][sic] calling up interactive ads played through box 610" (para. 159).

12. Dodson was cited by the Examiner for teaching a processor which simultaneously plays video while reacting to signals from a remote control and simultaneously allows access to the internet (*i.e.*, modem activity) (*see* Dodson, Figs. 1-9; col. 2, l. 47 to col. 3, l. 28) (Ans. page 23). Dodson teaches a controller (*i.e.*, processor) 108, remote control 206, and internet interface (*i.e.*, modem) 106 for interactively doing an internet search and overlaying a search query onto a displayed program (*i.e.*, movie) (col. 5, ll. 35-52 and Fig. 9).

13. According to the Examiner, it would have been obvious "to modify Hunter to incorporate the teaching as taught by Dodson in order to immediately provide additional information to the user (col. 1, ll. 40-55), and allow [a][sic] user to simultaneously watch the program and additional information on the same screen" (Ans. 23).

14. According to the Examiner, Hunter "discloses the user pay to access the recorded movie (para. 139)," but "does not specifically disclose a smart card" (Ans. 23).

15. Maruo was cited by the Examiner for teaching a smart card secured to a circuit board receiver, an intelligent transceiver, integral fastening of the smart card to a set-top box, and an external smart card slot. (*see* Maruo, Fig. 5B; col. 7, ll. 34-45 and col. 8, ll. 47-61; smart card 525,

POD 520 for inserting smart card 525) (Ans. 24-25). According to the Examiner, "POD 520 for inserting a smart card (col. 11, ll. 17-20; Fig. 5B) reads on the claimed feature of "a secondary external smart card" (Ans. 25).

16. According to the Examiner, it would have been obvious "to modify Hunter to use the teaching as taught by Maruo in order to improve convenience for [a][sic] user to pay the bill and reduce unauthorized user [sic] access [to a] pay per view program" (Ans. 24).

We will address the anticipation and obviousness issues in turn below.

## ANTICIPATION

### Principles of Law

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as they would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. Inc., v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

"If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is 'inherent' in its disclosure." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (internal citations omitted). "Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d at 745 (internal citations omitted).

*Analysis*

Appellants contend that "Hunter does not involve metadata" (Reply Br. 8) and instead "Hunter is focused on overwrite protocols" (Reply Br. 5). In our view, Hunter teaches metadata (Finding of Fact 3) such as pricing information, customer information, and decryption information. We note that Hunter's metadata is the same as Appellants' disclosed metadata (Finding of Fact 2). Thus, we disagree with Appellants' contention that Hunter does not involve metadata. We also note that Hunter further describes that "[w]hile a first-in-first-out protocol *may* be used for overwriting onto the hard drive module 230, the customer catalog information may serve to establish a different protocol" (para. 144) (emphasis added). Hunter teaches protocols other than first-in-first-out. Thus, we are not persuaded by Appellants' contention (Reply Br. 5-10) that Hunter does not anticipate claims 4 to 10, 12 to 16, 18 to 35, 37, 41, 42, 52

to 59, 61, 63, 72 to 77, and 79 to 100 because Hunter's first-in-first-out overwrite protocol does not meet the claim language.

With respect to whether or not Hunter teaches "metadata," we agree with the Examiner that Hunter meets this claim limitation, either expressly or inherently (Ans. 4, 10, 11, 14, 16, 17, 19-21). In our view, Hunter clearly teaches metadata (*i.e.*, data about movies) (Finding of Fact 3). More specifically, Hunter describes various types of metadata (Finding of Fact 3), just as Appellants do in their specification (Finding of Fact 2). Furthermore, Hunter packetizes the data and assembles it locally (Finding of Fact 8) using MPEG II compression (pars. 121, 165, 169, 173, and 175) by direct broadcast satellite ("DBS") (pars. 17, 51, and 98) just as Appellants disclose (Spec. 12 and 41).

Our broad interpretation of "metadata" includes any data about data, and in most of the claims on appeal, data about *movie* data in particular. Hunter teaches various types of movie data, such as movie "title, type, or category" (para. 12); encryption and decryption data (paras. 12, 16, and 65); pricing data (para. 65) and viewed-content information used for billing purposes (para. 103); content availability and/or scheduling data (paras. 61 and 68); time-based coding key C issued only when the user has a verified current account (paras. 82 and 83); "movie preference information" (paras. 142 and 143); customer profile information (para. 153); information on number of plays (para. 154) or time elapsed from first play (para. 161); and error codes used for assembling data packets (paras. 214-16) (Finding of Fact 3).

In our view, Hunter meets the various limitations of claims 4 to 10, 12 to 16, 18 to 35, 37, 41, 42, 52 to 59, 61, 63, 72 to 77, and 79 to 100 on

appeal, whether processed at the set-top box (CPU 80), the companion box (microprocessor 660), or at the central controller 36.

A majority of Appellants' other arguments with respect to the anticipation rejection are drawn to whether or not Hunter teaches "analyz[ing] locally received metadata" and "how to employ the results of such locally performed analysis to make local decisions" (Reply Br. 5). Appellants contend that, in Hunter, "[t]here is no analysis of metadata performed at the local receiver or set top box" (Reply Br. 7) and that "the Examiner is incorrect that use and analysis of metadata at the local receiver is inherent in Hunter" (Reply Br. 10). We agree with the Examiner's findings of fact and conclusions and adopt them as our own, along with some amplification of the Examiner's explanation of the teachings of Hunter.

We note that claim terms should be given their broadest reasonable meaning in their ordinary usage as such claim terms would be understood by one skilled in the art by way of definitions and the written description. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

In the instant case, while claims 4 to 10, 12 to 16, 18 to 35, 37, 41, 42, 52 to 59, 61, 63, 72 to 77, and 79 to 100 all recite various aspects of processing, analyzing, or operating on movie data and/or metadata, we note that only independent claims 23, 26, and 88, and their corresponding dependent claims, specifically require that the remote hardware device (claim 23) or set-top box (claims 26 and 88) contain software to process or analyze the content (*e.g.*, movie data) or metadata.

Claims 4 to 10, 12 to 16, 18 to 22, 25, 30 to 33, 35, 37, 41, 42, 52 to 59, 61, 63, 72 to 77, 79 to 87, and 91 to 100 broadly call for analysis or

processing of metadata, but do not specifically require that such analysis or processing occur "locally" or at the set-top box. While claim 41 recites a "processor for executing software, processing data … and for processing user input commands to permit access to the stored movie data under predetermined control conditions derived from the metadata," in our view the claim does not require that the processor determine the control conditions or derive the control conditions from the metadata (*i.e.*, this could be done by the central controller 36, or by a user). Accordingly, Appellants' arguments regarding local analysis of metadata are unpersuasive with respect to claims 4 to 10, 12 to 16, 18 to 22, 25, 30 to 33, 35, 37, 41, 42, 52 to 59, 61, 63, 72 to 77, 79 to 87, and 91 to 100.

With respect to independent claims 23, 26, 88, and their respective dependent claims, we find that these claims do require "software" at the set-top box for processing or analyzing metadata.

Hunter teaches software at the set-top box or remote hardware device "to process the metadata and manage the content according to its associated metadata" (claim 23), analyzing metadata to determine when a movie should be made available (claim 26), and composing an instruction to delete specific content (*i.e.*, a movie) and a "set-top box having logic therein that interprets the instruction and delete[s][sic] the previously store content referenced in the instruction" (claim 88) (Findings of Fact 4, 6, and 7).

Hunter teaches a device that analyzes metadata at the user station (CPU 80, SRAM 90, RAM 88 in set-top box 228, pars. 64-68; microprocessor 660 in companion box 610) (Finding of Fact 4). Hunter also analyzes metadata such as "number of plays" (para. 154) and "purchase-to-play time" (para. 161) in microprocessor 660 (*i.e.*, locally) to determine

whether or not to decrypt a movie and make it available for viewing (Finding of Fact 7).

Hunter teaches that metadata such as "headers in the datastream indicating movies or other content that have been preselected for recording" and "programming data ... including "content availability/scheduling data and content pricing data" (para. 65, and "time-based security codes B" (para. 68) are received by CPU 80 and used to control first-in-first-out processing/deleting/availability of movie data (paras. 128, 138, and 139). Hunter teaches that CPU 80 works in cooperation with decoder 82 to locate preselected movies and then permits recording based on scheduling data (paras. 65 and 68) (Finding of Fact 6).

With regard to claim 88, we note that while this claim recites a "method of remotely deleting content from a set top box" including "composing an instruction to delete specific content" and a set top box "having logic therein that interprets the instruction," in our view the instruction is not required to have been composed by the set top box, but instead could be composed by the content provider, or in the case of Hunter, the central controller 36. Therefore, Hunter's first-in-first-out deletion procedure anticipates claim 88.

In addition, Appellants' use of the term "remotely controlling" in claim 18, and of the term "remotely" in claims 83, 88, and 91, reads on either a remote connection between a content provider and a home viewer/user, or a remote control I/O device for controlling a set-top box. Thus, in our view, independent claims 83, 88, and 91 (and their corresponding dependent claims) do not require a set-top box to be "remote" from the content provider, and therefore broadly read on any type of remote

control for "controlling" (claim 18), "deleting" (claims 83 and 88), or "managing" (claim 91) data.

With respect to claims 9, 15, 25, and 57, Appellants assert that Hunter does not "re-broadcast" movie content and "does not, expressly or inherently, describe or disclose technology regarding re-broadcasting movie content" (Reply Br. 12), and make similar arguments with respect to claims 9 and 15 (App. Br. 15 and 17). We agree with the Examiner that sending individual new release movies every 30 minutes several times each meets the language of claim 9 (Ans. 6) and the similar language of claims 15, 25, and 57.

In our view, "broadcasting" and "re-broadcasting" do not require the use of satellite, but could broadly include transmission by other means (*e.g.*, internet or phone line). Since Hunter teaches "re-broadcasting" for the purpose of insuring complete movie reception when movie data is packetized (Finding of Fact 8), we conclude that Hunter anticipates claims 9, 15, 25, and 57.

We have considered all the arguments, including those in the Reply Brief filed on December 31, 2007, but find them unpersuasive for the reasons given above. *Cf. Hartman v. Nicholson*, 483 F.3d 1311, 1315 (Fed. Cir. 2007) (all remaining arguments were considered, but none were found that warrant reversal). In summary, all of the limitations of claims 4 to 10, 12 to 16, 18 to 35, 37, 41, 42, 52 to 59, 61, 63, 72 to 77, and 79 to 100 on appeal are found, either expressly or inherently, in the teachings of Hunter.

## OBVIOUSNESS

*Principles of Law*

The Examiner bears the initial burden of presenting a prima facie case of obviousness, and Appellants have the burden of presenting a rebuttal to the prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

The Examiner's "articulated reasoning . . . in the rejection must possess a rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Supreme Court, citing *Kahn*, 441 F.3d at 988, stated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. at 1741. However, "the analysis need not seek

out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

The Examiner bears the initial burden of presenting a prima facie case of obviousness, and Appellants have the burden of presenting a rebuttal to the prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

*Analysis*

Turning to the obviousness rejections of claims 11, 43 to 48, and 78, we find that Appellants have not presented any substantive patentability arguments directed to the merits of the Examiner's obviousness rejections. Appellants generally assert that Hunter, whether taken singly or in any combination with the other applied references, does not provide, inherently or otherwise, all of the elements of the respective base claims (claims 10, 43, and 41 respectively) (App. Br. 30, 32, and 34; Reply Br. 16 and 19). Appellants also assert generally that the Examiner has not provided any evidence of a motivation for one of ordinary skill in the art to modify Hunter (App. Br. 31, 33, and 34-35; Reply Br. 16-17 and 19-20).

The Examiner responds that the applied references teach or suggest all of the recited features of claims 11, 43 to 48, and 78 (Ans. 44, 45, and 47), that Hunter discloses that modifications may be made to the illustrated embodiments (Ans. 44, 46, and 48 *citing* Hunter, para. 218), and that the motivation to modify and combine references can either be found in the references or in the knowledge generally available to one of ordinary skill in the art (Ans. 45, 46, and 48). We agree with the Examiner's findings of fact and conclusions with respect to the obviousness rejections and make them our own. Furthermore, we note that Hunter and Maruo collectively teach or

suggest all of the features of independent claim 43 (*see* Findings of Fact 9 and 15), which is the only independent base claim rejected for obviousness and not rejected as being anticipated by Hunter.

We are not persuaded by Appellants' arguments. In our view, the Examiner has established a prima facie case of obviousness which has not been shown to be in error. We will address each obviousness rejection in turn.

*Obviousness Rejection of Claim 11 Over Hunter*

The Examiner's articulated reasoning in the rejection, that it would have been obvious to one of ordinary skill in the art to "modify Hunter to include storing the movie to be any time period such as at least one day, and preferably about a week" as long as "the time desired is limited to the capability and/or characteristics of the transmission medium and/or device limitations and/or operator desire to improve efficiency of movie services" (Ans. 22) (Finding of Fact 10), possesses a rational underpinning which supports the legal conclusion of obviousness. *Kahn*, 441 F.3d at 988.

In our view, "operator desire" in Hunter could include permitting a certain amount of time to lapse before making a movie available in order to allow for payment, verification of payment, and/or determining customer good standing (*see* Hunter, Figs. 9-11; paras. 12, 51, 83). And, in our view, "device limitations" in Hunter could include permitting a certain amount of time to lapse before making a movie available in order to allow for packet assembly (*see* Hunter, paras. 212-16) and insure complete movie data reception at the set-top box permitting a certain amount of time to lapse before making a movie available before sending the message "YOU'VE GOT FLICKS" (*see* Hunter, para. 139).

*Obviousness Rejection of Claim 78 Over Hunter and Dodson*

We agree with the Examiner that the motivation to combine Hunter and Dodson can be found in Dodson (col. 1, ll. 40-55) "to immediately provide additional information to a user" and to allow a user to simultaneously watch program and additional information on the same screen (Ans. 48) (Finding of Fact 13). We also agree with the Examiner's conclusion as to the obviousness of claim 78 over Hunter and Dodson (Findings of Fact 11-13).

Furthermore, we are not persuaded by Appellant's argument regarding any lack of motivation or suggestion to combine, because the Examiner's articulated reasoning in the rejection, that it would have been obvious to one of ordinary skill in the art "to modify Hunter to incorporate the teaching as taught by Dodson in order to immediately provide additional information to the user (col. 1, ll. 40-55), and allow [a][sic] user to simultaneously watch the program and additional information on the same screen" (Ans. 23) (Finding of Fact 13), possesses a rational underpinning which supports the legal conclusion of obviousness. *Kahn*, 441 F.3d at 988.

In addition, Hunter teaches that purchases may be made "*during*" the movie (para. 148) (Finding of Fact 11) (emphasis added), that "[a] remote control ... allows ordering a variety of merchandise ... through box 610's IR port, processor and modem communication link" (para. 159) (Finding of Fact 11), and that modem 650 is used for "ordering and paying for a pizza *while* watching a football game at a friend's house" (para. 159) (Finding of Fact 11) (emphasis added). In our view, Appellants have not met their burden of showing that the subject matter of claim 78 would not have been obvious over the collective teachings and suggestions of Hunter and Dodson.

*Obviousness Rejection of Claims 43 to 48 Over Hunter and Maruo*

The Examiner's articulated reasoning in the rejection, that it would have been obvious to one of ordinary skill in the art "to modify Hunter to use the teaching as taught by Maruo in order to improve convenience for [a][sic] user to pay the bill and reduce unauthorized user [sic] access [to a] pay per view program" (Ans. 24) (Finding of Fact 16), possesses a rational underpinning which supports the legal conclusion of obviousness. *Kahn*, 441 F.3d at 988. In our view, guaranteeing bill payment (suggested by Hunter) and prevention of unauthorized access (suggested by Maruo) would have been strong motivations for one of ordinary skill in the art to have combined Hunter and Maruo.

Appellants' contention that "Hunter makes no mention of 'control conditions derived from the metadata'" (App. Br. 32) is unpersuasive and misplaced. We note that while claim 41 recites permitting access to movie data under "predetermined control conditions derived from the metadata," claim 43 merely recites permitting access to the movies "under predetermined control conditions." In other words, *claim 43 does not recite "metadata,"* just "predetermined control conditions." Furthermore, in our view, neither claim 41 nor claim 43 requires that processor located at the set-top box *actually generate* the "predetermined control conditions." Although claims 41 and 43 call for storing movie data using predetermined control conditions, we find nothing in the language of these claims that requires the processor to generate the conditions (*e.g.*, the conditions could be generated by the content provider as occurs at Hunter's central controller 36).

Finally, we agree with the Examiner that Hunter teaches predetermined control conditions which are derived from metadata such as

code keys for decryption and ID header information used to determine availability (Ans. 14) (*see* Findings of Fact 3, 5 and 6). In our view, claims 43 to 48 would have been obvious to one of ordinary skill in the art at the time of Appellants' invention in view of the teachings and suggestions of Hunter and Maruo.

For all of the above reasons, Appellants' arguments have not persuaded us of error in the Examiner's rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Hunter, of claims 43 to 48 under 35 U.S.C. § 103(a) as being unpatentable over Hunter and Maruo, and of claim 78 under 35 U.S.C. § 103(a) as being unpatentable over Hunter and Dodson. Accordingly, we sustain the Examiner's obviousness rejections.

## CONCLUSIONS OF LAW

Anticipation of the claimed subject matter set forth in claims 4 to 10, 12 to 16, 18 to 35, 37, 41, 42, 52 to 59, 61, 63, 72 to 77, and 79 to 100 has been established by the Examiner because Hunter discloses, expressly or inherently, each and every limitation set forth in these claims. Obviousness of the claimed subject matter set forth in claims 11, 43 to 48, and 78 has been established by the Examiner.

## ORDER

The anticipation rejection of claims 4 to 10, 12 to 16, 18 to 35, 37, 41, 42, 52 to 59, 61, 63, 72 to 77, and 79 to 100 is affirmed, and the obviousness rejections of claims 11, 43 to 48, and 78 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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